REMARKS

Attached hereto is a Terminal Disclaimer to obviate the double patenting rejection over respectively the co-pending applications 11/508,136, Serial No. 11/508,132, and Serial No. 11/508,094. Thus, the rejection over obviousness type double patenting as a provisional rejection has now been mooted with regards to Claims 1, 2, 5, 6 and 9-11.

The present invention provides a unique manner of resolving a technical problem of having to wait a significant period of time before an initial display of an interactive animated display due to a large decoding load which can occur in order to provide an animated display overlaying buttons. The present invention is rendered by a specific reproducing of a plurality of graphical objects, the animation which form as now defined in our pending claims.

As can be appreciated, even with higher speed processors, by providing two or three seconds of animation from a significant number of pages of graphic data can require significant processing in order to support button animation that can employ three or more display buttons. The present invention addresses the significant time period that would have to be taken before an interactive display is actually supported or realized to the viewer, an issue not recognized nor addressed in the cited art.

In *Orthopedic Co., Inc. v. United States*, 217 USPQ 193 (C.A.F.C. 1983), the Federal Circuit set forth a useful guide for determining the scope and content of the prior art. Orthopedic, at pages 196-197, also focuses on the "problem" faced by the inventors:

> In determining the relevant art. . . one looks at the nature of the problem confronting the inventor.
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> * * *
>
> [W]ould it then be <u>nonobvious</u> to this person of ordinary skill in the art to <u>coordinate these elements in the same manner as the claims</u> in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the <u>strong temptation to rely on hindsight</u> while

undertaking this evaluation. It is wrong to use the patent in suit [the patent application before the Examiner] as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. <u>Monday morning quarterbacking is quite improper when resolving the question of nonobviousness.</u> (Emphasis added)

With our present invention, when our graphics data is appropriately set as defined in our recording medium to be read by a reproduction apparatus, the graphic data can be successfully supplied to a graphic decoder and subject to a decode processing by being grouped in an order so that the decoder can adequately support an immediate interactive display at a point in time before the entire graphics data set would be decoded. In this environment, each piece of graphics data in a graphics data set will define a graphic object with use of a pixel code representing a brightness component and a color-difference component of a pixel.

Thus, the present invention is able to quickly execute an initial display of the interactive display that uses animation. Furthermore, as a result of the present amendments, it is clear that the graphics data that is grouped is graphics data that defines graphics objects with use of a pixel code representing a brightness component and a color-difference component of a pixel, and that each one state of a button material is expressed using animation by continuously reproducing a plurality of pieces of graphics data. The present amendments also make clear what kind of data the graphics data grouped as state sets is. Please note that the grounds for the amendments to clarify the graphics data are Page 21, Line 27 to Page 22, Line 23 of the specification.

> "An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention." *See In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

Murase et al. (US Patent No. 5,907,658) discloses an invention pertaining to a recording medium that realizes interactivity by displaying sub-picture data composed of run length data, as items in a menu. This recording medium is a DVD-Video, and has recorded thereon a video object composed of a video stream, an audio stream, and a sub-picture stream multiplexed together. The video object is composed of a plurality of video object units, with each video object unit including video data (i.e., a GOP), sub-picture data, and a management information pack. The management information pack includes a PCI packet, and highlight information in the PCI pack realizes interactive operations in the aforementioned menu. Since the cited invention contains sub-picture data as a compositional element corresponding to graphics data, the cited invention and present invention share this as a common aspect. However, the *Murase et al.* reference and the present invention differ in the following three ways.

First, the way in which the states of the button materials are realized is different. According to *Murase et al.* Column 15, Lines 52-63 cited by the Examiner, in Figure 8 the reproduction apparatus displays, for the default operation, item # 1 as the selection state and other items as standard state. If the standard state is white, selection state blue, determination state red, then, only the item for item # 1 is blue. In this way, in *Murase et al.*, the states are realized simply by color changes such as red, blue and white, and are not realized by a plurality of graphics objects. In other words, *Murase et al.* realizes states of button materials by changing the display color of graphics according to an instruction of a color designation with respect to an item and not animation which as defined in our specification, is simulated movement of an object to the viewer. Webster's New College Dictionary also defines animate as to "create the illusion of motion."

More specifically, the structure defined in *Murase et al.* is for changing a state of a button material by <u>changing the color</u> which is a significantly different structure and operation from a structure for displaying a button material <u>using animation</u> and, therefore, the technical problem of taking a long time for an initial display due to a large decoding load (i.e., the technical problem of the present invention) is not recognized as a significant problem in *Murase et al.* In contrast, by reproducing a plurality of graphics objects, the present invention expresses the state of a button material by using animation. Furthermore since the graphic objects are grouped according to states of the button materials the graphics data can be read quickly, and the initial display of the interactive display can be realized quickly.

It is readily apparent that the *Murase et al.* reference does not recognize nor offer a solution for the problem addressed by the present invention, and is simply relying upon changing a color per se in the manner taught by *Murase et al.* which would teach away from realizing the advantages of our present invention to a person of ordinary skill in this field.

> "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley,* 27 F.3d 551, 553 (Fed. Cir. 1994); *see KSR,* 127 S. Ct. at 1739-40 (explaining that when the prior art teaches away from a combination, that combination is more likely to be nonobvious). Additionally, a reference may teach away from a use when that use would render the result inoperable. *McGinley v. Franklin Sports, Inc.,* 262 F.3d 1339, 1354 (Fed. Cir. 2001).
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> *In re Icon Health and Fitness, Inc.* 2007 U.S. App. Lexis 18244, *10

Second, the data that is grouped by our invention differs between *Murase et al.* and the present invention. According to *Murase et al.* Column 15, lines 52-63 cited by the Examiner, the highlight information in the PCI packet includes pieces of item information #1, #2, #3, #4, #5 ...#36, and in the example in FIG. 8, the pieces of item information are in correspondence with

eight menu items, namely "(1) stairs", "(2) kitchen",... "(8) no investigation." Since each piece of item information may have a standard state, a selection state or a determination state, in the case of item # 1 being in the selection state as in Figure 8, the items #2 to #8 are in the standard state. The item information of these items is in one group as shown in Figure 10B, and as such *Murase et al.* only groups data relating to a color pattern of buttons in accordance with states. Examining in detail this item information is, we found that the "item information #1, #2, #3, #4, #5..." in Figure 10B is, as shown by reference b3, includes "color pattern number," "start coordinate X1," "start coordinate Y1," "end coordinate X2," "end coordinate Y2," "peripheral position information," and "highlight command field." In this way, *Murase et al.* does not teach graphics data for defining a graphics object that is grouped, but only control information defining a color pattern, display coordinates and the like for display graphics that are grouped. In *Murase et al.* only simple information defining a color pattern, display coordinates and the like that are grouped, and, therefore, it cannot be said that *Murase et al.* groups graphics data that defines a graphics object with the use of values of pixels.

Third, data that defines graphics is not grouped in *Murase et al.* According to *Murase et al.*, Column 14, Lines 39-42 cited by the Examiner, in DVD a VOB can have a maximum of 32 sub-picture sub-streams, and the 32 sub-picture sub-streams have identification numbers 0 to 31. These sub-picture streams are composed of sub-picture packs, and each sub-picture pack includes run length data. Although the run length data constitutes graphics by defining values of pixels, the sub-picture data included in *Murase et al.'s* sub-picture stream is not grouped into data constituting respective items.

Given that (i) the way in which the states of the button materials are expressed is different, (ii) the data that is grouped is different, and (iii) it is not data representing design of

graphics that is grouped, it cannot be said that graphics data defining graphics objects is grouped in Murase. Accordingly, it is not appropriate to cite *Murase et al.* as a basis for denying the novelty of the present invention.

Furthermore *Murase et al.* does not resolve the technical problem of taking a long time for an initial display of an interactive display due to a large decoding load for displaying animation, and cannot suggest a solution to our technical problem. Therefore, *Murase et al.* also differs greatly from the present invention in terms of whether or not it provides a solution for the technical problem of the present application. Therefore, *Murase et al.* and the present invention are not the same invention under 35 U.S.C. §102.

The Office Action further rejected Claims 2, 6 and 13 as being obvious over a combination of the *Murase et al.* (U.S. Patent No. 5,907,658) in view of *Yamauchi* (U.S. Patent No. 6,381,398) under 35 U.S.C. §103.

Our recent discussion with Pinchus Laufer in the Office of Patent Legal Administration, who was involved in writing the Examination Guidelines for Determining Obviousness under 35 USC §103 in view of the Supreme Court decision in *KSR International Co. vs. Teleflex, Inc.* verified that the *KSR* decision still required a specific rationale that could not be based on hindsight for purportedly combining the elements in the prior art to meet an invention defined in the patent claims.

Mr. Laufer incorporated the following from the existing MPEP into the Guidelines.

As noted in the MPEP at §2143.02:

> A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.,* 550 U.S. ___, ___, 82

USPQ2d 1385, 1395 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). (underline added)

Applicant submits that any combination of references that must be modified beyond their functions is suggestive of an unintended use of hindsight that may have been utilized to drive the present rejection. This is particularly true for an Examiner who is attempting to provide a diligent effort that only patentable subject matter occurs. The *KSR* Guidelines do not justify such an approach. There is still a requirement for the Examiner to step back from the zeal of the examination process and to appreciate that a Patent Examiner has to wear both hats of advocating a position relative to the prior art while at the same time objectively rendering in a judge-like manner a decision on the patentability of the present claims.

As set forth in MPEP 2142,

> To reach a proper determination under 35 U.S.C. §103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Yamauchi discloses an authoring apparatus that interleaves video data, audio data and sub-picture data to obtain a video object. The video data, the audio data and the sub-picture data which are to constitute a video object are interleaved having each been given a reproduction start

time code and a reproduction end time code which show a reproduction start point and a reproduction end point, respectively (Figures 5A, 5B and 5C). A correction process is then performed to correct each piece of audio data corresponding to each of the plurality of video objects in accordance with a limitation imposed on each of the plurality of video objects dependent on a reproduction order. With this arrangement, it purportedly takes a short time period before a whole film application has been created by repeating partial modifications and deletions of video data from the viewpoint of a total design. This renders the production of a film application of the multi-version type realistic for producers (Figure 3).

The sub-picture stream targeted in *Yamauchi* is a DVD-Video sub-picture stream as shown in Figure 35D, which has the same data structure as the sub-picture stream in *Murase et al.* As such, as with *Murase et al.*, any idea of graphics data that defines graphics objects being grouped in accordance with states does not exist in *Yamauchi*.

Furthermore, since both of *Murase et al.* and *Yamauchi* lack the concept of how to speedily read graphics data that constitutes each frame of animation (a feature of the present invention), namely the feature that graphics data that defines graphics objects are grouped, is not obvious from *Murase et al.* and *Yamauchi*. Therefore, *Murase et al.* and *Yamauchi* cannot be cited as a basis for rejecting the non-obviousness of claim 1.

Since the novelty and non-obviousness of Claim 1 cannot be denied based on *Murase et al.* and *Yamauchi*, the novelty and non-obviousness of Claim 2, which depends from Claim 1, should not be denied. Similarly, Claims 5 and 6 directed to a reproduction apparatus, Claim 9 directed to a recording method, claim 10 directed to a computer-readable recording medium, and Claim 11 directed to a reproduction method, while belonging to different categories to Claim 1, include technical items corresponding to the technical features of Claim 1 and, therefore, the

novelty and non-obviousness of these claims should not be denied based on the *Murase et al.* and *Yamauchi*.

In summary, the functions taught by the *Murase et al.* reference is simply to provide a color change. The buttons indicate whether it is in a standard state of white, a selection state of blue, or a determination state of red such as described, for example, in Column 15, Line 35 through Column 16, Line 49.

Thus, *Murase et al.* simply teaches activating one of the eight items disclosed in the cited Figure 8 in the rejection, whereby a branch from a menu or a particular location with the menu buttons staying static, disclosed a state of the button simply by a change of color. Clearly changing the colors does not involve any animation of the button materials nor any unique utilization of the graphic object data in a manner claimed by our present invention.

Adding the function taught by the *Yamauchi* reference, namely to author a DVD-Video sub-picture stream is an interleaving of video data, audio data and sub-picture data to obtain the video object. *Yamauchi* teaches the function of permitting a correction of each piece of audio data correspond to each of the plurality of video objects. This approach purportedly provides a shortening of the time period in which to author a work.
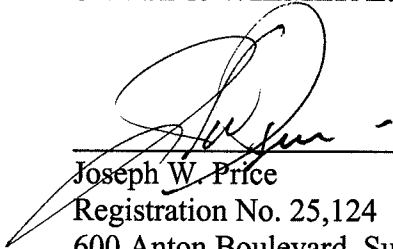
Yamauchi, like the *Murase et al.* reference, fails to recognize let alone offer any solution of the problems addressed and resolved by our present invention. Combining the specific functions under 35 U.S.C. §103 would still fail to permit a speedy reading of a large amount of graphic data that can constitute each frame of animation.

It is submitted that the present application is in condition for allowance and an early notification of the same is requested.

If the Examiner believes a telephone interview will help further the prosecution of the case, the undersigned attorney can be contacted at the listed telephone number.

Respectfully submitted,

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